

REMARKS

This Request for Continued Examination follows the outstanding Official Action dated 02/08/05 and is intended as a complete and proper response thereto. In particular, the present paper is presented with the view of advancing prosecution of this application on its merits and hopefully placing this case in a clear condition for allowance.

In order to render this Amendment responsive, a Petition for Extension of Time to Respond Within the Third Month Pursuant to § 1.136(a) is submitted herewith in duplicate along with the requisite petition fee of \$510.00 commensurate with the applicant's small entity status as previously established.

Claims 1-20 remain in the application. These remaining claims have been amended in accordance with the examiners detailed action. Reexamination and reconsideration of the application, as amended, is requested.

Claims 14 and 20 were initially rejected under 35 U.S.C. §112 as being indefinite. Claim 14 recited the limitations said liquid source". An amendment has been made to the dependency and now provides sufficient antecedent basis for the limitation. It is believed that this amendment clearly overcomes the examiners §112 rejection of claims 14 and 20 and places them in condition for allowance.

Claims 1, 5, 9, 10, 13-16, 19 and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Maroney 967 in view of Miles et al. 801 and an abstract of an article in the Journal of Food Science which the examiner has attempted to use as rebuttal evidence to the applicants affidavits. The Maroney and Miles et al. applications have been discussed in previous actions in this file at great length. The Maroney patent teaches a method of cutting cherries or de-pitting cherries using a water jet while the Miles et al. patent teaches the sizing of seed potatoes.

Independent Claims 1 and 9 have now been extensively amended in order to particularly claim the conveyor system for holding the potatoes and moving through the water jet. In particular, the limitations added claim a V-shaped upper and lower conveyor with the conveyors arranged in a stepped fashion such that the lower conveyor extends further at the starting point and the upper conveyor extends further at the ending point beyond the lower conveyor. Further, the V-shape of the conveyor belts is also claimed in order to grasp the upper and lower section of the potato and hold it between the conveyor belts at the relevant time. Finally, claim 9 more particularly adds these limitations along with the articulating limitation of the upper conveyor section. Thus, it is believed that these claims now clearly define over the prior art of record and thus, render the current Section 103 rejections moot.

Finally, the examiner is reminded that for prior art references to be combined to render obvious a subsequent invention under § 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q. 2d 1434, 1438(Fed. Cir. 1988). The teaching of the references can be

combined only if there is some suggestion or incentive in the prior art to do so. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). Hindsight is forbidden. It is impermissible to use the claims as a framework from which to pick and choose individual references to recreate the claimed invention. *Id.* at 1600; *W.L. Gore*, 220 U.S.P.Q. at 312. Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir. 1992); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Applicant respectfully takes issue with the examiners' current 103 rejections and it is believed that a great deal of hindsight is being used to pick and choose individual references to recreate the claimed invention. For example, claims 4 and 8 as previously presented stand rejected under 35 U.S.C. §103 as being unpatentable over Maroney 967 in view of Miles et al. 801, a journal abstract and Flaming 211 as applied to the claims above in further view of Mirabello 729. The examiner in this case is using five pieces of prior art as well as claiming that water inherently contains chemical additives and that thus, the use of these additives is inherent. It is believed that this type of rejection is clearly forbidden based upon case law and the normal practice of the United States Patent and Trademark Office (USPTO). However, as described above, independent claims 1 and 9 have now been extensively amended and as such, render these arguments as well as the rejections of the dependent claims moot as none of the prior art shows the features which have been added to claims 1 and 9.

The examiner also argues that the affidavits are insufficient to overcome the rejections of claims 1-20 as they fail to state that there is no evidence that a person skilled in the art working on the problem knew of the teachings of the above cited references or if they knew of them, they would still be unable to solve these problems. It is believed that requiring evidence that persons skilled in the art who are presumably working on the problem knew of the teachings of the references in this case and were still unable to solve these problems is a misstatement of the MPEP §716.04. If this rejection is continued, applicant asks that the examiner kindly supply case law setting forth this requirement as the plain language of the MPEP §716.04 does not make this requirement as the examiner has stated.

Based upon the newly amended independent claims 1 and 9 which now include limitations as to the type of conveyor, the arrangement of the upper and lower conveyor belt, the shapes of the belts, as well as the articulating ability of the upper belt, it is believed that the current rejections have been overcome and rendered moot. Further, based upon the above discussion of the current rejections and discussion of the affidavits presented in this case, it is believed that the examiners §103 rejections as discussed above and as discussed previously has been overcome.

In light of the foregoing discussion of the applied art of record, the presentation of the amended schedule of claims and the indication as to how such claims are considered to clearly and patentably define over the references, it is believed that the patentable nature of the claims has been demonstrated.

In view of the above remarks, reconsideration and allowance of the claims is kindly requested. Should any matters remain outstanding that may be handle over the phone the examiner is encouraged to call.

Respectfully Submitted,

Date: _____

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Curtis V. Harr
Attorney for the Applicant
Reg. No. 37,844
P.O. Box 2842
Fargo, ND 58108-2842
Voice (701) 298-3001
Fax (701) 298-3002